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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,651	01/13/2005	Roman Lenz	EL/2-22714/A/PCT	9351

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EXAMINER

SANDERS, KRIELLION ANTIONETTE

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 07/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/521,651	Applicant(s) LENZ ET AL.	
	Examiner Kriellion A. Sanders	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 6, 7, 9 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claims 6, 7 and 13 recite the limitation "formula 1a ". There is insufficient antecedent basis for this limitation in the claim. Claims 6, 7 and 13 lack antecedent basis for formula 1a.

In claim 9, the term, "either" indicates there is an alternative process for producing the colour filters. However, no alternative process is listed and the presence of an alternative process would render the claim indefinite. The claim fails to particularly point out and distinctly claim applicant's process.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 4 is rejected under 35 USC 102(b) as being clearly anticipated over Rochat et al, US

Patent No. 4,579,949.

Applicant states at page 7 of the present specification, that the diketopyrroles of formula (1) are produced analogously to generally known methods as described in Rochat et al.

Therefor, applicant did not invent the method of claim 4.

Claims 1-3, and 5-8 are rejected under 35 USC 102(b) as being clearly anticipated over Wallquist et al, US Patent No. 5,738,719 or Rochat et al, US Patent No. 4,579,949.

Each of Wallquist et al. and Rochat et al. discloses polymeric compositions comprising diketopyrrole pigments that correspond structurally to those of the presently claimed invention, and are produced by an analogous method. No patentable difference may readily be ascertained between the present and patented inventions. See Wallquist et al. at col. 1, line 66 through col. 5, line 62. See Rochat et al at col. 4, lines 8-28 and col. 7, line 60 through col. 8, line 4.

Response to Arguments

1. Applicant's arguments filed 5/02/2006 have been fully considered but they are not persuasive.

Applicant attempts to differentiate over the diketopyrroles of the patented inventions by including claim limitations that the present diketopyrroles are of a blue-tinged red shade. Wallquist et al in example 5 indicates that the diketopyrroles are a red transparent shade. The phrase blue-tinged red shade is subjective. This phrase cannot be said to conclusively differentiate over the patented diketopyrroles.

Applicant attempts to differentiate over the diketopyrroles of the patented inventions by including claim limitations that the present diketopyrroles have a transmission at 570-580nm of less than 5% and a transmission at 615 nm of at least 80%. Because the present diketopyrroles

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are structurally identical to those of the prior art and are produced by an analogous process, it is not clear that they differentiate over the diketopyrroles of Wallquist et al and Rochet et al.

Claim 9 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Rochat et al, US Patent No. 4579949.

Rochat et al indicates that polyacrylates may be colored with the diketopyrrole pigments of the invention. See col. 7, line 60 through col. 8, line 4.

Claim Rejections - 35 USC § 102

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallquist et al, US Patent No. 5,738,719 or Rochat et al, US Patent No. 4,579,949 as applied to claims 1-9 above, and further in view of WO 02/10288.

The world patent teaches that diketopyrroles are commonly used to make colour filters. See page 8, fourth complete paragraph. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to employ the diketopyrroles of either Wallquist et al or Rochat et al. in a colour filter in the manner suggested by the World patent.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kriellion A. Sanders whose telephone number is 571-272-1122. The examiner can normally be reached on Monday through Thursday 6:30-7:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kriellion A. Sanders
Primary Examiner
Art Unit 1714

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